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Naoya Takao

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28970

7590

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SHAW PITTMAN

IP GROUP

1650 TYSONS BOULEVARD

SUITE 1300

MCLEAN, VA 22102

EXAMINER

BOCCIO, VINCENT F

ART UNIT

PAPER NUMBER

2616

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/593,368

Applicant(s)

TAKAO, NAOYA

Examiner

Vincent F. Boccio

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Election on 6/4/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-81 is/are pending in the application.
- 4a) Of the above claim(s) 8,10,11,17-26,37,39-49 and 55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,12-16,27-36,38,50-52,56-71,74 and 75 is/are rejected.
- 7) ☒ Claim(s) 53,54,72 and 73 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5.7.8.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2616.

**Election/Restrictions**

1. Applicant's election with traverse of the restriction requirement on 5/7/04 {provisionally elects claims 1-7, 9, 12-16, 27-36, 38, 50-54, 56-75} in the reply filed on 6/8/04 is acknowledged. The traversal is on the ground(s) that "since the subject matter of all 81 claims is sufficiently related that a thorough and complete search for the subject matter of the elected claims would necessarily encompass a thorough and complete search of the subject matter of the non-elected claims", also "to avoid unnecessary delays and expense to the applicants". This is not found persuasive because applicant has not stated that the embodiments called out are obvious over one another, further the delay and expense are also not persuasive to the examiner, the examiner further is burdened by numerous claims and distinct embodiments claimed.

The requirement is still deemed proper and is therefore made FINAL.

**Claim Objections**

1. Claims 1, 58 are objected to because of the following informalities:

Claim 1, line 27, recites "the reproduction means not carries out the interactive", the examiner suggests,

"the reproduction means does not carry out the interactive"

"the reproduction means doesn't carry out the interactive", to provide additional clarity to the claim.

Claim 58, line 28, recites "foe", the examiner suggests "for".

Please review and amend all other occurrences, as suggested

Appropriate correction is required.

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**Claim Rejections - 35 USC § 112**

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

According to Fig. 18 of applicant's disclosure, indicates that upon a special mode the control data cannot be obtained, therefore, upgraded, but, indicates that the interactive operation cannot be obtained, but, claim 4, recites

"not contains {or does not contain}, "a control command" - and further recites,

"displays the image performing operations when ... in the special mode.".

How does one skilled in the art perform special playback, have no control command "data", and perform displaying of image performing operations ??????????

**Claim Rejections - 35 USC § 112**

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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2. Claims 2-7, 12-16, 29-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites,

"the reproducing means carries out an interactive operation"

and

"the reproducing means not carries (doesn't or does not) out the interactive operation when the apparatus is in special playback mode",

therefore, during special no interactive operation associated with services is carries out in special mode, while

claim 2 recites "the reproducing means reproduces signals representing content of services reproduced under the special mode, therefore, while claim 1 recites that in the special mode does not carrier out the interactive, while claim 2 negates or broadens claim 1, but fails to provide any limitations that allow or change the ability to do so in the claims.

Therefore, rendering claim 2 and all dependent claims to be indefinite and all dependent claims under claim 2, dependent claims 3-7, are also indefinite in view of claim 2 and will not be further addressed, in view thereof.

Claim 12 is rejected for the same reasons as claim 2, including all dependent claims 13-16, therefrom.

Claim 29 is also rejected for the same reasons as claim 2 including dependent claim 30.

**Claim Rejections - 35 USC § 102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United

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States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 1-4, 7, 9, 12-14, 27-29, 32-36, 38, 50-52, 56-64 and 75 are rejected under 35 U.S.C. 102(e) as being anticipated by Kitsukawa et al. (US 6,628,713).

Regarding claim 1, Kitsukawa discloses and meets the limitations associated with a recording/reproduction apparatus receiving a digital broadcast comprising:

- receiving means for receiving a transport stream containing (Fig. 2, "satellite", col. 5, "MPEG" and "transport IC" & Fig. 3 etc.....), control data realizing interactive operations (Fig. 4, "Advertisement Data", col. 2, "advertising information received along with the broadcast");
- converting means (Fig. 3, met by de-multiplexing the advertisements from the transport stream to be stored and/or later rendered) for generating in accordance with packets as to a desired service selecting from the transport stream being received (col. 2, "advertising information received simultaneously with the scenes" or "may be received prior to receipt of the scenes or TV programs");
- recording means for recording the stream (selected) from the converting means and readout means (met by the R/R device or the read head of the device) for reading out the stream recorded on the medium (col. 2, "prerecorded", col. 4, "storage device 107", col. 6, "selection of a broadcast for automatic recording");
- operation handling means (Fig. 1, "122", or Fig. 2, "5/51" or Fig. 3, "front panel 40 or 39");
- reproduction means having
  - a receiving mode (col. 2, "services used in scenes of live and ...");

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- a playback modes of normal and special ("prerecorded TV programs");
- wherein in either receiving mode and/or a reproduction mode the control data (advertisement) changes the signal representing contents of the services being outputted in accordance with the input of the operator (col. 9, "selecting the AD. Mark with a cursor ... presents a list of items superimposed over the display", "all clothing items of a scene", "whereupon selecting of a particular item of interest ... results in a second display comprising particular advertising information about that product");
  - o wherein the reproduction means carries out a normal mode and a special reproduction mode of operation, wherein in one mode or another mode or special mode wherein
    - "not carries out", or does not carry out the interactive operation when the apparatus is in the special playback mode (met by another mode or a special mode of the system, wherein the display of advertisements is not presented, met by col. 3, "The NON-advertisement mode", or another or special mode) or a no ad mode.

Regarding claims 2, 3, 4, 7, 12, 14, 29, 33-36, Kitsukawa further meets the limitation of:

wherein the converting means generates a data stream for reproduction/(receiving mode) containing a data stream for normal playback and not containing a data stream for special playback (two modes of operation one with AD, one without); and

wherein the reproducing means reproduces signals representing contents of services reproduced under the normal playback mode (Ad mode), in accordance with the data stream for normal playback when the apparatus is in the normal playback mode; and

wherein the reproduction means reproduced signals representing contents of services reproduced under special playback mode (third mode col. 8, lines 11-13, "advertising information ... recalled at a time different from a display time of a scene in which the corresponding advertising item appears." Or an Ad mode, which is different than first AD mode);

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wherein during the third mode col. 8, since recalled at a time different from a display time of a scene, the normal mode control data to generate control commands are not used, in view of, "recalled at a time that is different", reading on the claim as recited.

Claims 9, 27-28, 32, 38, 50-52 are analyzed and disclosed with respect to the claim 1 etc., above.

Claim 13, is analyzed and discussed with respect to the claims above, wherein one mode the reproducing means does not displays the image for interactive or no ad mode.

Claims 56, 57 are analyzed with respect to claim 1, but, further recites,

O "wherein the converting means carries out one of not generates (generating) the data stream for special playback (which reads on in special not generating ads./services), while reproducing the video.

Claims 58-64, are analyzed and discussed with respect to the claims above, wherein Kitsukawa provides three mode, AD mode, No ad mode and ad mode wherein the ads are recalled a time different from the display time of a scene, therefore,

further meets the limitations of:

"not allowing a special playback, "a part of or whole", reads on no Ad mode, as further recited,

not allowing special playback of a part (reads on "recalled at a time different", therefore, ad times different, col. 8);

further the converting means makes special playback so as to contain whether or not allowing special playback, having Ads or not, reads on AD mode and col. 8, mode wherein Ad. are recalled that is different from a normal Ad mode with Ads with times to trigger, therefore, the converting means generates or provides to the medium thereafter, contains information indicating whether is not allowing special playback or a different playback, changing the operation, using the data or not, when contain the data special for a special playback mode or the second mode operation exists, col. 8.

Regarding claim 75, Kitsukawa further meets the limitations of wherein a computer readable medium of provided with instructions (col. 4, lines 25-39, "instructions for the



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processor/CPU 109", being a computer system), controlling operations of the

- the converting circuit, the recording part, the readout part, the decoding part, as analyzed and discussed with respect to claim 1 above (also reference Figs. 1-11 and corresponding disclosures).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 5-6, 15-16, 30-31, 65-71, 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitsukawa et al. (US 6,282,713).

Regarding claims 5, 15, 30, Kitsukawa fails to disclose upgrading wherein the system detects the upgraded information and further suspends operations when upgrading.

The examiner takes official notice that upgrading control data is well known and further it is deemed further obvious that upon receiving an upgrade the system would be required to handle the upgrade loading and installing, therefore, it would

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have been obvious to one skilled in the art at the time of the invention to allow upgrading of control data, wherein the system would suspend other operations to handle and install the upgrade data as would be considered to those skilled in the art.

Regarding claims 6, 16, 31, Kitsukawa fails to disclose outputting a signal to notify the suspension to the operator when the display of the image is suspended.

The examiner takes official notice that providing status indicating mode or other is well known in the art, therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Kitsukawa by providing a status message up suspension to allow the user to acknowledge the mode of operation, as is well known in the art.

Regarding claims 65-71, Kitsukawa fails to mention a pause mode, therefore, fails to disclose

- suspending display of image {for performing interactive operations}, claim 66,
- keep displaying the image {for interactive operations}, claim 67;
- restarts the interactive operations after pause.

The examiner takes official notice that the pause function is well, being well known to resume previous operation after pause, further obvious to either suspend or maintain interactive operational images and modes, during pause mode, either to freeze the current image upon the pause or even change the display to other operations or images resuming for example, therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Kitsukawa by providing a pause function and to resume previous operations after pause, further upon a pause to freeze the last image on the display or even change the display to another interactive scene mode, as is obvious to those skilled in the art.

Regarding claim 74, Kitsukawa further meets the limitation of the system/reproducing means can carry out processing (of user inputs to retrieve more information about the Ads provided thru the internet-Web pages), therefore, for external communications (col. 8, line 37-, "electronic links to Web pages of manufactures and dealers").

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Allowable Subject Matter

4. Claims 53-54 and 72-73 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 53, the prior art of record fails to teach disclose or fairly suggest the combination of claim 1 and claim 53, as recited, wherein the reproduction **means not uses or (doesn't use) control data for** interactive operations obtained

**at a beginning of special playback mode {when switching} to a normal playback mode after carrying out the special mode**

if a service ID at beginning of the special mode and a service ID at end of the special mode **are not {do not}** coincide with each other when playback modes are switched to in a sequence of the normal to special modes of operation.

Regarding claim 54, the prior art of record fails to teach, disclose or fairly suggest, in combination with claim 1 and claim 54, as recited, wherein the reproduction **means not uses {doesn't use or does not use} control data** for interactive operations obtained

**at beginning of a special playback mode in a normal playback mode after carrying out the special**

if a version of the control data at beginning of the special mode and a version of the control data the end of **special are not {does not} coincide** with each other when playback modes are switched to in a sequence of normal to special and normal playback modes.

Regarding claim 72, the prior art of record fails to teach, disclose or fairly suggest in combination with claim 69, wherein upon a reproduction and a pause mode, as recited,

- wherein the reproducing means completes the operations under the control data being carried out at the beginning of the pause mode and not accept further inputs when the apparatus is in the pause mode.

Regarding claim 73 is considered to claim substantially the same as claim 72, which also depends from claim 69, as recited;

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- wherein the reproducing means not carries out the operation under the control data depending on time when the reproduction apparatus is in the pause mode.

Please review all claim language for clarity including the objected claims, reference the suggestions pointed out by the examiner.

**Contact Fax Information**

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communication intended for entry)

or:

(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

**Contact Information**

Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Thursday, 8:00 AM to 5:00 PM Vincent F. Boccio (703) 306-3022.

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service (703) 306-0377.

Primary Examiner, Boccio, Vincent  
8/19/04

  
VINCENT BOCCIO  
PRIMARY EXAMINER